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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,956	03/11/2004	Larry E. Wittmeyer JR.	772204-0006-0002	4878

27910 7590 12/11/2008
STINSON MORRISON HECKER LLP
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1201 WALNUT STREET, SUITE 2800
KANSAS CITY, MO 64106-2150

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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12/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,956	Applicant(s) WITTMAYER, LARRY E.	
	Examiner VICTOR S. CHANG	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 1-44 and 54-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-53 and 63-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' remarks filed on 10/9/2008 have been entered. Claims 45-53 and 63-70 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections Based on Prior Art

3. Claims 45-47, 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye [US 5390819] for reasons of record in the Office Actions mailed 4/13/2006, 1/3/2007 and 9/19/2007.
4. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye [US 5390819] in view of James [US 2415012] for reasons of record in the Office Actions mailed 4/13/2006, 1/3/2007 and 9/19/2007.
5. Claims 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye [US 5390819] for reasons of record made in the Office Actions mailed 4/13/2006, 1/3/2007 and 9/19/2007.

Response to Arguments

6. Applicant argues at Remarks pages 2-3 that

“The Examiner maintains that it would have been obvious to use the structured stack of flexible sheets shown in the Kaye Patent as a recreational toy because the stack, when expanded, will provide for recreation to a user. Yet there is no evidence indicating that repositionable notepads or other adhesive notepads were suggested or promoted for use as a recreational toy prior to the Applicant's invention. To the contrary, the Kaye Patent suggests that the stack of sheets be used in a dispenser. The Declaration of Larry E. Wittmeyer, Jr., the inventor of the subject invention previously submitted provides evidence that other parties did not use or promote the use of repositionable notepads as a recreational toy prior to the date of the invention. Nothing has been presented by the Examiner to contradict that evidence.”

However, regarding applicant's contention that no evidence has been presented by the examiner to show that repositionable notepads or other adhesive notepads were suggested or promoted for use as a recreational toy, applicant is again directed to the Office action mailed 1/3/2007, page 3, lines 10-15 for examiner's position as to why it would have been obvious to one having ordinary skill in the art.

Applicant argues at page 3 that

“It is noted that a clarification should be made to the Response to Office Action filed on March 19, 2008 and Declaration of Larry E Wittmeyer, Jr. submitted therewith. In that Response and supporting Declaration, it was noted that 3M had begun selling repositionable notepads in conjunction with the Slinky® brand name. The fact that 3M had begun marketing this product with the Slinky® brand name was cited as evidence of copying to support the patentability of the present invention. Upon further investigation, Mr. Wittmeyer has learned that the 3M products sold in conjunction with the Slinky® brand name do not have repositionable adhesive on successive sheets disposed on alternate adjacent opposite edges as required by the present claims. Instead, the 3M products comprise successive sheets having adhesive on the same edge. Thus, while the note pads are being sold in conjunction with the Slinky® brand name, which was not done by 3M prior to commercialization of the present invention, such 3M notepads are not being sold as a toy as claimed by the present application.”

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However, applicant has failed to show any evidence that that the prior art is incapable to be useful as a toy. Regarding the 3M promotion, applicant's statement appears to be mere opinion rather than factual evidence. In particular, applicant fails to provide any dated evidentiary support that 3M promotion is necessarily instigated by applicant's product launch. Nor is there any factual support that the method of 3M product usage is necessarily later than applicant's conception of the method of use. The declaration is deficient.

Conclusion

7. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794